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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/539,174	06/14/2005	Bernd Haber	02/085 NUT	5165

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EXAMINER

MCCORMICK, MELENIE LEE

ART UNIT	PAPER NUMBER
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1655

DATE MAILED: 07/06/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/539,174

Applicant(s)

HABER ET AL.

Examiner

Melenie McCormick

Art Unit

1655

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 06/05.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

DETAILED ACTION

Claims 1-20 are presented for examination on the merits.

Claim Objections

Claims 9,10,14,15,19 and 20 are objected to under 37 CFR 1.75(c) as being in improper form because a multiple dependent claim cannot depend from another multiple dependent claim. See MPEP § 608.01(n). Accordingly, the claims have not been further treated on the merits.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 15-20 are rejected under 35 U.S.C. 101 because the claimed recitation of a use, without setting forth any steps involved in the process, results in an improper definition of a process, i.e., results in a claim which is not a proper process claim under 35 U.S.C. 101. See for example *Ex parte Dunki*, 153 USPQ 678 (Bd.App. 1967) and *Clinical Products, Ltd v. Brenner*, 255 F. Supp. 131, 149 USPQ 475 (D.D.C. 1966).

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 15-20 provide for the use of a cholesterol-reducing agent, but, since the claims do not set forth any steps involved in the method/process, it is unclear what

Art Unit: 1655

method/process applicant is intending to encompass. A claim is indefinite where it merely recites a use without any active, positive steps delimiting how this use is actually practiced.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-20 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-11 of copending Application No. 10/538,903. Although the conflicting claims are not identical, they are not patentably distinct because each are drawn to cholesterol reducing agents comprising at least one carob product and at least one n-3 fatty acid, wherein the carob product is insoluble carob fiber and the n-3 fatty acid is a polyunsaturated fatty acid having a chain length > C12 and is selected from a group which consists of

5,8,11,14,17-eicosapentaenoic acid and 4,7,10,13,16,19-docosahexaenoic acid.

Further, the claims of '903 encompass and/or are encompassed by the instant claims.

This is a provisional obvious-type double patenting rejection because the conflicting claims have in fact not been patented.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Marco et al. (US 5,856,313), Breivik et al. (US 5,502,077), and McKenney (Lipid Management).

Marco et al. beneficially teach a carob product which contains insoluble carob fiber (see e.g. col 1, lines 5-10). Marco et al. further beneficially teach that the carob product has a hypocholesterol-aemiant effect, which can counteract the effects of modern cholesterol-rich diets (see e.g. col 1, lines 34-39). Marco et al. also disclose that in rats fed a high cholesterol diet, the increase in cholesterol in a test group which was fed the carob fiber product was significantly lower than those fed another type of fiber (see e.g. all of column 5). Therefore, the carob product beneficially taught by Marco et al. would intrinsically have the effect of reducing cholesterol. Marco et al. do not beneficially teach that the product additionally contains at least one n-3 fatty acid or at least one cholesterol-reducing active compound.

Breivik et al. beneficially teach a fatty acid composition which comprises omega-3-fatty acids (see e.g. abstract). Breivik et al. further beneficially teach that the composition contains omega-3 fatty acids, specifically, a combination of 5,8,11,14,17-eicosapentaenoic acid and 4,7,10,13,16,19-docosahexaenoic acid (see e.g. claim 1). It is further disclosed by Breivik et al. that the composition is useful for treatment or prophylaxis of multiple risk factors known for cardiovascular disease, including hypertriglyceridemia (see e.g. col 10, lines 34-39) and that it has been shown that the composition lowers total serum cholesterol significantly (see e.g. col 9, lines 19-24).

McKenney beneficially teaches a number of treatments for hypercholesterolemia, including several cholesterol-reducing active compounds. McKenney beneficially teaches that statins, bile acid resins (bile acid sequestrants), niacin (a nicotinic acid derivative), and fibrates are useful in reducing cholesterol (see e.g. 301-304). McKenney further beneficially teaches that fiber from vegetables and dietary adjuncts such as fiber and stanol/sterol esters can lower LDL cholesterol (see e.g. p. 300), which would read on the instantly claimed phytosterols, plant sterols and cholesterol-reducing plant extracts.

It would have been obvious to one of ordinary skill in the art at the time the claimed invention was made to combine the insoluble fiber containing carob product beneficially taught by Marco et al. with the n-3 fatty acid composition beneficially taught by Breivik et al and any of the cholesterol reducing active compounds beneficially taught by McKenney and well known in the art to obtain a cholesterol lowering agent as instantly claimed. It would have been obvious to one of ordinary skill in the art at the

time the claimed invention was made to combine the instant ingredients for their known benefit- i.e. reducing cholesterol -since each is well known in the art for the same purpose and for the following reasons. It is well known that it is *prima facie* obvious to combine two or more ingredients each of which is taught by the prior art to be useful for the same purpose in order to form a third composition which is useful for the same purpose (as well as to use the combination for that purpose). The idea for combining them flows logically from their having been used individually in the prior art. In re Sussman, 1943 C.D. 518; In re Pinten, 459 F.2d 1053, 173 USPQ 801 (CCPA 1972); In re Susi, 58 CCPA 1074, 1079-80; 440 F.2d 442, 445; 169 USPQ 423, 426 (1971); In re Crockett, 47 CCPA 1018, 1020-21; 279 F.2d 274, 276-277; 126 USPQ 186, 188 (1960). This rejection is based upon the well established proposition of patent law that no invention resides in combining old ingredients of known properties where the results obtained thereby are no more than the additive effect of the ingredients. The adjustment of particular conventional working conditions (e.g. the particular result-effective combination of one or more of the instantly claimed agents or the particular form of the agent) is deemed merely a matter of judicious selection and routine optimization which is well within the purview of the skilled artisan.

From the teachings of the references, it is apparent that one of ordinary skill in the art would have had a reasonable expectation of success in producing the claimed invention. Therefore, the invention as a whole was *prima facie* obvious to one of ordinary skill in the art at the time the invention was made, as evidenced by the references, especially in the absence of evidence to the contrary.

Conclusion

No claim is allowed.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

References on the Information Disclosure Statements filed on 06/06/05 and 06/14/05 were not considered because copies of some references were not provided. Although applicant indicated that the references were provided in copending application 10/538,903, the references were not provided in that application.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Melenie McCormick whose telephone number is (571) 272-8037. The examiner can normally be reached on M-F 7:30am-4:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terry McKelvey can be reached on (571) 272-0775. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 1655

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



CHRISTOPHER R. TATE
PRIMARY EXAMINER